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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,977	11/20/2001	Chris Ingersoll	COMM-005	1716

7590 11/03/2004

DAVID B. RITCHIE
THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,977	Applicant(s) INGERSOLL, CHRIS	
	Examiner CESAR B PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-27 and 30-37 is/are allowed.
- 6) ☒ Claim(s) 1-24, 28 and 38-43 is/are rejected.
- 7) ☒ Claim(s) 29, 44-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) <input type="checkbox"/> | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2178

DETAILED ACTION

1. This action is responsive to the application filed on 11/20/2001.

This action is made Non-Final.

2. Claims 1-50 are pending in the case. Claims 1, 9, 15, 22, 25, 27-30, 38, and 44 are independent claims.

Drawings

3. The drawings filed on 11/20/2001 have been approved by the examiner.

Claim Objections

4. Claims 15-21, and 44-50 are objected to because of the following informalities: Claims 15, and 44 recite “to all version s closer” line 8. It appears that this is a typographical error, which should be written as “to all versions closer”. Appropriate correction is required.

5. Claims 29, and 44-50 are objected to because of the following informalities: Claims 29, and 44 recite “said message ha” lines 23, and 22 respectively. It appears that this is a typographical error, which should be written as “said message has”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-21 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter. Claims 1, 9, and 15 recite a method which reads on a human user carrying out the steps manually with pen and paper, and/or mentally. For example, a user manually translating documents to be mailed to participants or employee of a company or different companies, so that everyone can understand the information found in the documents. Additionally, there are no apparatus and/or computer involved in these methods.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 9-14, 28, and 38-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 9, 28, and 38 recite the limitation "which of said documents" in lines 8-9, and 8 respectively. There is only one 'single document' previously referred to in this claim. It is uncertain which "documents" this claim is addressing. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al, hereinafter Moody (Pat. # 5,890,177, 3/30/1999).

Regarding independent claim 22, Moody discloses an author creating an original document using a word processing program—*native/community version equivalence determiner* – which is to be sent out to editors in a local area network (col. 4, lines 20-43).

Moreover, Moody discloses the author sends copies of the original document to other editors using email, floppy disks, etc.,—*native version document sender coupled to said native version/community version determiner--*. Application programs, and floppy disks, and communications adaptor are interconnected within the same computer (col. 4, lines 33-43, col. 3, lines 27-30, 52-col.4, line 6).

Furthermore, Moody discloses the return of the edited copies by the editors to the original author via the network—*native/community/other converted document sender coupled to said native version document converter--* (col. 4, lines 44-51, col. 3, lines 27-30, 52-col.4, line 6).

Art Unit: 2178

Moody fails to explicitly disclose: *a native document converter*.. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a document converter in the editors' computers connected through a local area network, because Moody teaches that the editors do not have to use the same word processing program (col. 4, lines 38-43). Thus, providing the benefit of allowing the editors to edit the document in an environment their more familiar with, which allows these editors to be more effective, and spending less time than in a word processor they're not acquainted.

Regarding claim 23, which depends on claim 22, Moody discloses the transmission to the edited documents via email message—*community version document message encapsulator* – which is to be sent out to editors in a local area network (col. 4, lines 34-36). Moody fails to explicitly disclose: *a native version/other converted document attachment saver*.. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have attached the documents to the email, because Moody teaches above sending the documents via the email. Thus, providing the benefit of rapid delivery of the copies of the original document using the features found in email.

Regarding claim 24, which depends on claim 22, Moody discloses consolidating various edited copies into a final document—*transformation registry* –, and then converting the different versions into the original author's format using filters or translators which is to be sent out to editors in a local area network (col. 4, lines 34-36).

Art Unit: 2178

Allowable Subject Matter

13. Claims 25-27, and 30-37 are allowed.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Muranaga et al. (Pat. # 5,671,428), and Li et al. (Pat. # 20040205613).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-2148. The examiner can normally be reached on Monday through Friday (every other Friday off) from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

Commissioner for Patents

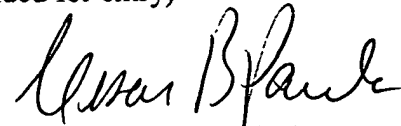
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

Art Unit: 2178

- (703) 703-872-9306, (for all Formal communications intended for entry)

A handwritten signature in black ink, appearing to read "Cesar B Paula", written in a cursive style.

CESAR B PAULA

Patent Examiner

Art Unit 2178

10/27/04